

REMARKS

Introductory remarks

The present letter is filed in response to the Examiner's non-final Action of January 26, 2009. Applicant thanks the Examiner for withdrawing the finality of the previous action. Currently pending claims 1, 24, 26-30, 32, 34, 35, and 40-49 have not been amended in view of the following arguments, which are directed to the patentability of independent claim 1.

In the Action, the Examiner is combining Bent and Cristiano to reject claim 1 on obviousness grounds. Differently from the previous actions, the Examiner is now acknowledging that Bent does not disclose a "motion transmission member." According to the Examiner, "a motion transmission member that is a lever" is disclosed in Cristiano. In particular, the Examiner states that Cristiano teaches that lever 16 allows piston 128 to be oriented non-parallel to another element to which motion is transmitted, and that such teaching can be added to the teachings of Bent to obtain the subject matter of claim 1.

Applicant respectfully disagrees with the Examiner in view of the arguments below.

The Examiner has not shown where some of the features of claim 1 are present in Bent or Cristiano

Claim 1 recites that the lever is "*rotatably connected at opposed ends thereof to [the] slidable blade and to the stem of [the] piston*" and that "*the lever [is] connected to a chassis of the surgical device at a central position thereof.*" There is neither recitation of these features of claim 1 in the Examiner's action, nor an explanation as to where they are to be found in Bent or Cristiano.

Addition of Cristiano's lever to Bent would render Bent inoperable for its intended purpose and would change the principle of operation of Bent – see MPEP § 2143.01

The core of Bent's invention is the presence of regulating means 77, which regulate fluid access into a chamber 96 arranged upstream of piston 104. See, for example, column 5, lines 31-56 of Bent. Such regulating means 77 comprise a valve arrangement extending parallel to piston assembly 82 and are connected to chamber 96 by a plurality of calibrated channels, e.g., channels 78, 98 as shown, for example, in Figure 1 of Bent. Regulating means 77 need to be specifically associated with a trigger member 177 in order to allow a movement of Bent's operating blades directly corresponding to the movement of the surgeon's fingers on trigger member 177. See column 2, lines 5-9 of Bent. The specific construction of regulating means 77 represents the heart of Bent's disclosure (see, e.g., column 1, line 63 through column 2, line 5; column 5, lines 37-40; column 9, lines 42-48 of Bent).

However, to properly perform their function, Bent's regulating means 77 need to be located at an intermediate portion of the device, i.e. trigger portion 16 (see, e.g., Bent's Figures 1 and 3). Therefore, addition of Cristiano's lever would destroy the arrangement of Bent's regulating means because it would entail a displacement—both linear and angular—of piston assembly 82 which, in turn, would subtract vital space to the regulating means 77 and the associated trigger member 16. In particular, the Examiner is invited to look at Figures 1-3 of Bent, where it is shown that regulating means 77 practically extend along the entire horizontal length of that section of the device, thus providing no space for insertion of Cristiano's lever between the trigger 16 and the blades 20.

Where should Cristiano's lever be attached in Bent?

As already noted in one of the sections above, claim 1 of the present application recites that the lever is "*rotatably connected . . . to the stem of [the] piston.*" The stem of Bent's piston is indicated with reference numeral 102. See, e.g., Figure 1 in Bent. However, Bent's moving blade 20 is directly fixed at piston 100 and NOT at piston stem 102. See, e.g., column 5, line 68 through column 6, line 4. See also the entire section 'OPERATION' of Bent, starting at column 8, line 37, where the movement of blades 20 following depression of trigger 16 is shown. In that section there is no mention at all of piston stem 102. Therefore, connecting Cristiano's lever at Bent's piston stem 102 would not further movement of blade 20.

Cristiano

With all due respect, Applicant is still not convinced by the Examiner's reasoning as to why Cristiano is analogous art. The Examiner is mentioning *In re Oetiker*, where it is stated (and highlighted by the Examiner, see the Examiner's action of November 4, 2008, page 6) that a prior art reference should be "reasonably pertinent to the particular problem with which the applicant was concerned." The particular problem with which the applicant is concerned is "removal of bone, cartilaginous and the like tissues" or "removal of a tissue fragment" (see claim 1). On the other hand, Cristiano is a "stapling mechanism" where staples are fed into a work piece. This is substantially the opposite of what the applicant is doing. One staples and the other removes. How can something that staples be "reasonably pertinent" to something that removes? The problem solved by the Applicant's invention is not just "transmitting motion from a piston to another element" as put by the Examiner at page 6 of the November 4, 2008 Action. The problem solved by Applicant is that of avoiding undesired motions or swinging of the osteotome when removing tissue (page 5, lines 24-25 of the present application).

Conclusions

In view of the above arguments, reconsideration and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-4194. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection herewith may be charged to deposit account no. 50-4194.

I hereby certify that this correspondence
is being electronically transmitted on

April 13, 2009

(date of deposit)

/Alessandro Steinfl/

(signature of person transmitting)

Respectfully submitted,

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